UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/614,953	07/08/2003	Young-Gook Ha	3364P116	7127

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EXAMINER
FABER, DAVID

ART UNIT	PAPER NUMBER
2178	

MAIL DATE	DELIVERY MODE
07/03/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Advisory Action **Before the Filing of an Appeal Brief**	10/614,953	HA ET AL.
	Examiner	Art Unit
	DAVID FABER	2178

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 20 June 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

   a) ☒ The period for reply expires *3* months from the mailing date of the final rejection.

   b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will <u>not</u> be entered because

   (a)☐ They raise new issues that would require further consideration and/or search (see NOTE below);

   (b)☐ They raise the issue of new matter (see NOTE below);

   (c)☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

   (d)☐ They present additional claims without canceling a corresponding number of finally rejected claims.

      NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☐ Applicant's reply has overcome the following rejection(s): _____.

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

   The status of the claim(s) is (or will be) as follows:

   Claim(s) allowed: _____.

   Claim(s) objected to: _____.

   Claim(s) rejected: *1-15*.

   Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will <u>not</u> be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will <u>not</u> be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
   <u>See Continuation Sheet.</u>

12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____

13. ☐ Other: _____.

                                 /CESAR B PAULA/
                                 Primary Examiner, Art Unit 2178

Continuation of 11. does NOT place the application in condition for allowance because:

1.   Applicant's arguments filed 20 June 2008 have been fully considered but they are not persuasive.

2.   On pages 8-9, in regards to Claims 1-7, and 12-14 rejected under 35 U.S.C. 101, Applicant argues that amended claims provide a useful, concrete and tangible result which is directed towards statutory subject matter under 35 USC 101. However, the Examiner disagrees.

This argument is not persuasive as a complete 101 analysis starts with whether a claim falls into a statutory category of invention, as the claim only recites software, the claim fails to fall within a statutory category of invention as it is not a machine, manufacture, composition of matter nor a process. The next step in the analysis is whether a judicial exception is present, which there is and they then the question is whether the exception is practically applied by producing a useful, concrete and tangible result or transformation. However, this argument is moot as the rejection was over the claims failing to fall within a statutory category of invention.

Furthermore, Claims 1-7, and 12-14 lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 101. For claims 1-7, and 12-14, the claim language in the claims failed to disclose or mention what is included a system at all; thus, the claims are viewed as software in view of data structures. The use of the word "system" does not inherently mean that claim is directed to a physical machine. Therefore, the claims, themselves, lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 USC 101. They are clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory. They are, at best, functional descriptive material per se. Thus, in regards to claims 1-7, and 12-14, the claims, as written, appear to be claiming "software systems" i.e. systems without hardware indication, which is computer program per se. The claims as written do not recite any hardware indication, therefore, viewed as "software systems".

3.   On pages 9-11, in regards to Claims 1-12 rejected under 35 USC 103(a), Applicant argues that the cited references fail to teach or suggest every limitation of the claim limitations stating that Applicant's business rules are different than Cornelia's wherein Applicant's business context rules are used to create documents with context conditions for a specific business context where Applicant discloses a context condition from the specification is described as such as "Condition-Geopolitical = IT, Rename ('Address,' Indirizzo')," where IT stands for Italian and the Rename context condition chances the term "address" to its Italian translation. However, the Examiner disagrees.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., context conditions such as "Condition-Geopolitical = IT, Rename ('Address,' Indirizzo'), where IT stands for Italian and the Rename context condition chances the term "address" to its Italian translation) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See In re Van Geuns, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

According to the claim language of the claim limitations, the claims do not disclose Applicant's view of business context rules or indicate that the context rules could be different from Person based on the recited claim language of the claim limitations. Therefore Person's disclosure, along in view of the cited references, views upon the language of the claim limitation. Thus, Person et al discloses Word contains templates, which contain parts of a document and features used for a specific type of document. Person et al's discloses where context conditions are used by formulation rules where the template created allows the user to easily enter information onto ASK or FILLIN field by requiring only the user just to point, click, and type to fill out a form. (Page 4, Paragraph 4; FIG 6.4) Since the user is only required to fill out the ASK or FILLIN fields on the form, then context rules are applied. This process acts as a context processor that discloses an embodiment using a template showing context conditions allowing the user only have to point, click, and type information in a already constructed form by the template's context rules.

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have modified Cornelia et al's method with Person et al's disclosure since Person et al's disclosure of using a Microsoft Word template is a tool one could have used to further increase efficiency, productivity, and consistency while reducing company's costs when creating a document.

Furthermore, Cornelia et al, Person et al and Bauer et al fail to specifically disclose business context rules, a document for a specific type of business, and wherein the business context rules includes context conditions for acting on text for a specific business context. However, Poole et al discloses specifying content to be included into a document is to meet certain business rules and regulations wherein the content fragments of the document have integrity by virtue of being compliant with one or more business requirements. (Col 5, lines 3-7, 18-21) Thus, Poole et al discloses the content must follow all the conditions specified by the rules to be included in the document, wherein the rules describe a specific business context for the content in the document to be made.

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have combined Cornelia et al's, Person et al's, and Bauer et al's methods with Poole et al's method since it would have provided the benefit of creating dynamic documents that may be replicated to gain repeated benefit of flexibility of using one method while customizable to follow business rules and regulations.

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